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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEX ROCHE

Appeal 2009-004783
Application 10/088,715
Technology Center 3600

Decided: December 17, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1 and 63-73 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed an automated print on demand service over a network that matches customers for print services to a plurality of print service providers. (Spec. 3:4-7). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of operating an on-line retailing operation for selling a plurality of print products to a plurality of retail and business customers, said print products supplied by at least one print merchant, said method comprising the steps of:
 - displaying a plurality of image items for on-line viewing by said retail customers at a content retailer web site operated by or for a content retailer, said plurality of image items being made available to said content retailer for public merchandizing at said content retailer web site by at least one third party content provider;
 - offering a direct service to business customers for generating and ordering print products out of their own content;
 - transacting orders of a first type between said retail customers and said content retailer for supply at least one print product based on said customers ordering at least one print product after viewing at least one of said image items at said content retailer web site, wherein the at least one print product includes at least one of said image items made available for merchandizing by said at least one third party content provider;

transacting orders of a second type between
(i) said content retailer and said print merchant for fulfillment of said first type order by said print merchant; and
(ii) said business customers and said print merchant for fulfillment of business customer orders by said print merchant; and
transacting an order of a third type between said print merchant and a print service provider for printing and shipping said at one print product to either said retail customers or said business customers on the basis of the print product ordered by the retail or business customer.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Garfinkle	US 6,133,985	Oct. 17, 2000
Arnold	US 6,016,504	Jun. 18, 2000
von Rosen	US 6,493,677 B1	Dec. 10, 2002
Blumberg	US 2003/0140315 A1	Jul. 24, 2003

Media Flex, The Company. Obtained from:
<http://web.archive.org/web/19990430063122/www.mediaflex.com/secondlevel/about.htm>13/5/2008 10:43:39 AM.

Kinko's Prints It Big. Obtained from:
<http://proquest.umi.com/pqdweb?index=11&did=51055841&SrchMode=1&sid=4&Fmt=3...> 9/11/2007.

The following rejections are before us for review:

1. Claims 1, 63-64, 67-68, and 72-73 are rejected under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, and MediaFlex.
2. Claims 65-66 are rejected under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, MediaFlex, and Blumberg.

3. Claim 69 is rejected under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, MediaFlex, and Arnold.

4. Claims 70-71 are rejected under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, MediaFlex, Arnold, and Kinko's.

THE ISSUES

At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regards to claim 1, 63-71, and 73, this issue turns on whether it would have been obvious to combine the teachings of Garfinkle, von Rosen, and MediaFlex to meet the cited claim limitations.

With regards to claim 72 this issue turns on whether it would have been obvious to combine the teachings of Garfinkle, von Rosen, and MediaFlex and to provide an itemized bill.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. Garfinkle is directed to a method of producing digital images and distributing visual prints produced from the digital images (Title). Based on orders, at least one a visual image is produced from the stored digital image in response to the order (Abstract).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Garfinkle discloses that the photographer may have a developer 12 and a fulfillment center 20 involved in the process (Fig. 1).

FF3. Garfinkle discloses that the developer 12 may act as an intermediary between the photographer 8 and the entity that develops the roll of film. The establishment that fulfills, charges, and delivers the order will be referred to as the “fulfillment center” 20 (Col. 3:5-25).

FF4. MediaFlex discloses an Online Print Store in which you can open a Virtual Print Store as a licensee with the right to re-sell pics (pictures) in printed form (Page 6:6-9).

FF5. von Rosen has disclosed a method for ordering customized merchandise over a computer network (Title).

FF6. von Rosen discloses that a consumer may create customized branded merchandise such as soda and bottles and order it over the Internet to automate production and shipping (Col. 2:2-12).

FF7. von Rosen discloses an itemized bill in Fig. 11B.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary

considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Claims 1, 63-71, and 73

The Appellant argues that the rejection of claim 1 is improper because there would have been no reason to combine the teachings of Garfinkle, von Rosen and MediaFlex (Br. 4). The Appellant argues that providing direct access to an on-line print center as suggested by MediaFlex would render Garfinkle inoperable since Garfinkle requires that a developer, scanning center, and image servers be provided to allow for the development of photographic images from film and scanning at a scanning center (Br. 5).

In contrast, the Examiner has determined that the Garfinkle, von Rosen, and Media flex have been properly combined in the rejection of claim 1. The Examiner has determined that all the claimed elements are known and that the combination of cited features yields predictable results and would have been obvious to one of ordinary skill in the art (Ans. 6).

We agree with the Examiner. Despite the Appellant’s contention, Garfinkle is not limited to the use of a scanning centers. Garfinkle also discloses that the developer 12 may act as an intermediary between the photographer 8 and the entity that develops the roll of film (FF3). Garfinkle also discloses that a “fulfillment center” 20 charges, and delivers the order (FF3). Thus Garfinkle discloses that photos are delivered by the “fulfillment center” 20. MediaFlex discloses an Online Print Store in which you can open a Virtual Print Store as a licensee with the right to re-sell pics in printed form (FF4) and is thus related to Garfinkle in that both references are

related to the sale of photos. von Rosen further discloses that a consumer may create customized branded merchandise and order it over the Internet to automate production and shipping (FF6). Here, the Appellant has not argued that the cited references do not show any of the claimed elements, only that their combination is improper. We disagree with this contention since Garfinkle and Mediaflex are both related to the sale and delivery of digital photos and von Rosen is directed to a method of automating a production and shipping process (FF6). The modification of the system of Garfinkle to have an Online Print Store as taught by Mediaflex and an automated method of ordering them as taught by von Rosen is considered an obvious, predictable combination of known elements for their respective functions and to have a method of selling pictures which could reach more customers and have an automated method of shipping and ordering them.

For these reasons the rejection of claim 1 is sustained. The Appellant has provided the same arguments for claims 63-69, 70-71, and 73 and the rejection of these claims is sustained for these same reasons.

Claim 72

The Appellant argues that the rejection of claims 72 is improper because von Rosen fails to disclose the claim limitation for “itemizing separately, for each of a plurality of print service providers, a delivery price for delivery from the print service provider to a delivery address” (Br. 6, Reply Br. 4).

The Examiner has acknowledged that von Rosen only discloses a single print service provider but asserts that performing such tasks for a

plurality of providers versus a single provider falls within the skills of one ordinary skill in the art and would have been obvious (Ans. 7).

We agree with the Examiner. von Rosen discloses an itemized bill (FF7) but it does not show the bill itemized for plural vendors. The modification of the bill to itemize the charges for each vendor, such as a delivery service for each print service provider is considered an obvious expedient to provide a more detailed bill and for the customer to see each of the specific charges. Bills sent to customers frequently are broken down into the respective costs for each respective vendor so the customer can see where each portion of the payment was charged to keep track of expenditures. The modification of the combination of Garfinkle, von Rosen, and MediaFlex to itemize separately the cost for each item on the bill is considered an obvious modification well within the skill of one of ordinary skill in the art to provide a more detailed bill to the customer. “[A] court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR at 418*. For these reasons the rejection of claim 72 is affirmed.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1, 63-64, 67-68, and 72-73 under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, and MediaFlex.

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 65-66 under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, MediaFlex, and Blumberg.

We conclude that Appellant has not shown that the Examiner erred in rejecting claim 69 under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, MediaFlex, and Arnold.

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 70-71 under 35 U.S.C. § 103(a) as unpatentable over Garfinkle, von Rosen, MediaFlex, Arnold and Kinko's.

DECISION

The Examiner's rejection of claims 1 and 63-73 is sustained.

AFFIRMED

MP

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